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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/732,786	12/11/2000	Yasushi Ichikawa	Q62216	2733

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SUGHRUE, MION, ZINN, MACPEAK & SEAS
2100 Pennsylvania Avenue, N.W.
Washington, DC 20037-3202

EXAMINER

DUONG, THANH P

ART UNIT	PAPER NUMBER
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3711

DATE MAILED: 09/20/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

LC

Office Action Summary	Application No.		Applicant(s)	
	09/732,786		ICHIKAWA ET AL.	
	Examiner		Art Unit	
	Tom P Duong		3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 July 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 5) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claims 9 and 10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 9 and 10 recite the expression "...selected from the group consisting essentially of..." is an improper Markush group claim. See *Ex parte Markush*, 1925 C.D. 126 (Comm'r Pat. 1925). for proper Markush group claim.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sullivan (6,204,331) and (6,162,134) in view of Ueshima et al. (5,502,095). Regarding claims 1 and 9, Sullivan discloses the core and/or the interior layer include one or more silicone materials such as silicone polymers, silicone fluids, silicone elastomers, and silicone resins (See Col. 3, line 27-310). Sullivan does not expressly teach that the golf ball composition is blended with at least one of a silicone rubber powder, silicone resin powder, and composite powder but Sullivan

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discloses that the polymers can be combined with fillers, additives, and solvents to result in products generally termed as silicones. (Col. 20, lines 21-23). Ueshima et al. discloses the thermoplastic elastomer composition consist of component (C), polyorganosiloxane.

Polyorganosiloxane is blended with resin or rubber or filler such as a silicone rubber powder. (Col. 6, line 61-65). Ueshima further teaches that this blended composition can be used as an elemental material for sport and leisure goods (e.g. golf club grip, baseball ball bat grip, swimming and etc.) and other rubber contacts. It would have been obvious in one of ordinary skill in the art at the time of the invention to include the silicone rubber powder of Ueshima and other form of silicone fillers or powders in Sullivan silicone resin to provide a golf ball with improved flexibility, ease of molding and high resilience. Regarding claim 2, Sullivan discloses that the silicone rubber in the interior layer or core of a golf ball can be coated with primers such as silicate esters, silicone pastes, silicone resins or reactive silanes (See Col. 29, lines 15-18). Regarding claims 3 and 8, Sullivan discloses the silicone elastomers comprise cross-linked polydimethylsiloxanes (Col. 21, lines 57-60). Sullivan does not disclose the exact composition methylphenylpolysiloxane but Sullivan discloses the properties of polydimethylsiloxanes are typically modified by substitution of methyl groups on the silicone atom by hydrogen, alkyl, phenyl, or organofunctional group. Regarding claim 4, Sullivan discloses silicone resins are cured through the formation of siloxane linkages by the condensation of silanols (Col 31, lines 16-17). Regarding claim 5, Sullivan shows the particle size within the range of 0.5 to 50 μm and a particle size distribution ranging from 0.1 to 100 μm . (See Col. 24, Table 11). Regarding claims 6, Sullivan does not disclose the amount of blended silicone in the composition. Ueshima et al. teaches that the amount of polydimethylsiloxane added is 0.01 – 10 parts by weight which is equivalent to 0.01 – 10% by weight. It would have been obvious in one of ordinary skill in the

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art at the time of the invention to include the silicone rubber/resin/composite of Sullivan to have 0.01-10% polydimethylsiloxane by weight in the blended composition to provide excellent moldability, resilience, and flight performance. Regarding claim 7, Ueshima teaches that the particles are spherical. (See Col. 6, line 23). The Applicant should also note that a change in the shape in the shape of a prior art device is a design consideration within the skill of the art. *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966). Regarding claim 10, Sullivan discloses various ionomer resins and the rest of the compositions, as claimed by the Applicant, are cited throughout his patent application. Regarding claim 11, Sullivan discloses that ethylene ionomer resin with a metal salt of an unsaturated carboxylic acid such as acrylic acid, methacrylic acid or maleic acid, which could be neutralized with a metal ions such as sodium or zinc (Col. 2, lines 1-5). Regarding claim 12, Sullivan shows the ethylene acrylic acid copolymers with a Shore D hardness of 40-50 with a 20% acid content by weight (see Col. 11, Table 1). Regarding claim 13, Sullivan shows the formulation for molded core with 70.7% of a high cis-polybutadiene (See Col. 39, Table 20). Claim 14 recites limitations similar to claims 1 and 10; thus, claim 14 is rejected for the same reasons as applied in claims 1 and 10, above. Claim 15 recites limitations similar to claims 1 and 13; thus, claim 15 is rejected for the same reasons as applied in claims 1 and 13, above.

Response to Arguments

3. Applicant's arguments filed 7/24/02 have been fully considered but they are not persuasive.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case,

(a) Applicant argues that Ueshima does not describe a composition used in a golf ball. Ueshima clearly stated that the composition can be used as an elemental material for sport and leisure goods. *Answer: Golf ball is a sporting object and is categorized under sporting goods.*

(b) Applicant argues that the material of Ueshima does not teach mechanical properties, heat resistance, and oil resistance having a beneficial affect on the golf ball of Sullivan. *Answer: Ueshima discloses that the composition provide excellent characteristic such as strength, compression set, heat resistance, weather resistance, grease resistance. (Col. 11, lines 21-27). In addition, Tables 1 and 2 clearly show that the compositions have small wear or more durable and MFR which is an indication of good formability or molding. Thus, the composition of Ueshima has characteristics and mechanical properties which are applicable to Sullivan's golf ball.*

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THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

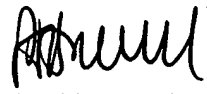
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tom P Duong whose telephone number is (703) 305-4559. The examiner can normally be reached on 8:00AM - 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Sewell can be reached on (703) 308-2126. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7768 for regular communications and (703) 305-3579 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-4148.

Tom Duong
September 12, 2002


Paul T. Sewell
Supervisory Patent Examiner
Group 3700